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10/706,048	11/13/2003	Isabelle Rollat-Corvol	5725.0425-01	9222

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EXAMINER

SOROUGH, LAYLA

ART UNIT	PAPER NUMBER
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1617

MAIL DATE	DELIVERY MODE
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10/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/706,048	Applicant(s) ROLLAT-CORVOL ET AL.	
	Examiner Layla Soroush	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-44 is/are pending in the application.
- 4a) Of the above claim(s) 21-28 and 41-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-20,29-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/20/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Office Action is in response to the Applicant's reply filed July 11, 2007 to the restriction requirement made on June 15, 2006.

Applicant's arguments regarding the restriction requirement have been considered. Applicant's argument that the distinction is not a significant difference is not persuasive. Examiner submit that chapter 800 of the MPEP permits Examiner to make a Restriction Requirement between products, method of treating or using, and process of making. The argument that the groups are classified in the same class and subclass and therefore there is no search burden is not persuasive; because the Restriction Requirement is not solely made on classification but also on an Examination burden. Examiner is aware that if the composition is found allowable, the process claims will be rejoined; please see Restriction Requirement mailed on June 15, 2006 pages 6 and 7.

Applicant's argument that there is no patentable difference between the species is not persuasive. In a group restriction, a species election is only made for examination purposes. If the species elected is not found in the prior art then Examiner will continue search to other species claimed.

The requirement is still deemed proper and is therefore made **FINAL**.

Claims 41-44 are withdrawn as being dependent on a nonelected group of the restriction requirement. Claims 21-28 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142(b), as being drawn to non-elected subject matter. The claims corresponding to the elected subject matter are claims 1, 3-20, and 29-40 are herein acted on the merits.

Claim Objections

Claim 19 is objected to under 37 CFR 1.75(c) as being in improper form for further limiting the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form. Claim 19 recites conditioning agents which are not recited in claim 1.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 is viewed as indefinite because it recites the limitations "conditioning agent is insoluble" and "insoluble silicones." It is unclear what these agents are insoluble in.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3-19,29-32 rejected under 35 U.S.C. 102(b) as being anticipated by Quack et al (US 4,150,216 -- IDS).

Quack et al. teach hair-treatment compositions containing 0.1-10% branched water dispersible sulfo-group containing polyesters (abstract, col 18, lines 37-42). The polyesters of Quack et al. are made of the following radicals: dicarboxylic acids (e.g. succinic acid, azelaic acid), diols (e.g. ethylene glycol, propylene glycol), dicarboxylic acids carrying SO₃M (e.g. sodium sulfosuccinic acid) and multifunctional reagents (e.g. glycerin, pentaerythriol, trimethylolpropane, trimethylolethane). (col 9-16). The composition of Quack et al. may contain alcohol, water, silicone oils, waxes, fats as well as quaternary ammonium compounds (e.g. pentaerythylstearyl ammonium chloride (col 18, lines 9-26; col 19 Example 3). The compositions of Quack et al. may be in the form of tonics, lotions, and sprayable formulation (col 18 lines 2-8). The compositions are applied to hair to set hair, to improve its texture and to shape it (col 1 lines 5-9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Quack et al (US 4,150,216 --- IDS), as applied to claims 1,3-19,29-32 above, and further in view of George et al. (US Pat No. 5662,893 -- IDS).

Quack et al. is as discussed above.

The reference does not teach the claimed cationic and/or amphoteric polymers as conditioning agents.

George et al. teaches these agents are conventionally used in hair formulations as conditioning agents (col 6 line 25-col 7 line 67).

It would have been obvious to one having ordinary skill in the art at the time of the claimed invention was made to use conditioning agents of George et al. for hair care compositions of Quack et al. The motivation to make such an incorporation is because the claimed cationic and/or amphoteric polymers are taught to be useful in hair formulations and provide improve combing and improved feel (softness) to the hair after shampooing (col 6 lines 30-35). Therefore, a skilled artisan would have reasonable expectation of successfully producing similar compositions with similar efficacies and results.

Claims 33-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quack et al (US 4,150,216), as applied to claims 1,3-19,29-32 above, and further in view of Singleton et al. (US Pat No. 5,320,836 -- IDS).

Quack et al. is as discussed above.

Although the reference teaches sprayable composition, the reference does not explicitly teach the claimed the claimed propellant.

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Singleton teaches aerosol hair care compositions containing conventional propellants such as aliphatic hydrocarbons and dimethyl ether (col 4 lines 34-66).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use propellants taught by Singleton. The motivation to use the propellant is because Quack et al. teaches the use of sprayable hair compositions and Singleton teaches such sprayable compositions. Therefore, a skilled artisan would have reasonable expectation of successfully producing a sprayable composition with the propellant.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-20, and 29-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1, 14-24, 26-27, and 29 of U.S. Patent No. 6039933. Although the conflicting claims are not identical,

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they are not patentably distinct from each other because the invention herein is drawn to a cosmetic composition for treating keratin fibers comprising: at least one branched sulphonic polyester; and at least one conditioning agent chosen from non-volatile silicones, cationic and amphoteric polymers and cationic and amphiphilic surfactants whereas the prior art teaches a cosmetic composition according to claim 1, wherein said at least one fixing polymer is selected from anionic, cationic, amphoteric and non-ionic polymers.

It would have been obvious to a skilled artisan that the similar composition would be useful as a cosmetic for treatment of the hair because the prior art uses similar components as claimed.

Claims 1, 3-20, and 29-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-22 of U.S. Patent No. 6692730. Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention herein is drawn to a cosmetic composition for treating keratin fibers comprising: at least one branched sulphonic polyester; and at least one conditioning agent chosen from non-volatile silicones, cationic and amphoteric polymers and cationic and amphiphilic surfactants whereas the prior art teaches a composition for washing keratinous materials, comprising, in a cosmetically acceptable aqueous medium, particles consisting essentially of aluminium oxide and having a mean primary size of less than 200 nm, at least one conditioning agent soluble or insoluble in the cosmetically acceptable aqueous medium, the conditioning agent being a cationic surfactant, a cationic polymer, a silicone, a

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vegetable oil, a ceramide, an anionic polymer, an amphoteric polymer or mixtures thereof, and at least one detergent surfactant, said composition not simultaneously containing an anionic surfactant and an amphoteric or nonionic surfactant.

It would have been obvious to a skilled artisan that a similar composition would be useful as a cosmetic for treatment of the hair because the prior art uses similar components as claimed.

Claims 1, 3-20, and 29-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-19 of copending application No. 10/320707. Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention herein is drawn to a cosmetic composition for treating keratin fibers comprising: at least one branched sulphonic polyester; and at least one conditioning agent chosen from non-volatile silicones, cationic and amphoteric polymers and cationic and amphiphilic surfactants whereas the prior art teaches a Styling composition packaged in an aerosol device, comprising from 45% to 65% by weight of a liquid phase containing, in dissolved or finely dispersed form in a cosmetically acceptable aqueous or aqueous-alcoholic liquid medium, at least one branched sulphonic polyester, and from 35% to 55% by weight of dimethyl ether as propellant, the total water content of the liquid phase being between 65% and 99% by weight.

It would have been obvious to a skilled artisan that a similar composition would be useful as a cosmetic for treatment of the hair because the prior art uses similar components as claimed.

Claims 1, 3-20, and 29-40 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of copending application No. 11/030296. Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention herein is drawn to a cosmetic composition for treating keratin fibers comprising: at least one branched sulphonic polyester; and at least one conditioning agent chosen from non-volatile silicones, cationic and amphoteric polymers and cationic and amphiphilic surfactants whereas the prior art teaches a A composition for washing keratin materials, comprising, in a cosmetically acceptable aqueous medium, at least one polymer chosen from cationic and amphoteric polymers, at least one detergent surfactant chosen from anionic, nonionic and amphoteric detergent surfactants, and at least one drawing polymer with a drawing power of greater than 5 cm.

It would have been obvious to a skilled artisan that a similar composition would be useful as a cosmetic for treatment of the hair because the prior art uses similar components as claimed.

Declaration

The 37 C.F.R. 1.132 Affidavits has been considered but is not persuasive. The reference of record teaches the use of branched sulphopolyesters as claimed. Further, an affidavits cannot overcome an anticipatory rejection. See rejections above.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Layla Soroush whose telephone number is (571)272-5008. The examiner can normally be reached on 8:30a.m.-5:00p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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